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IN THE

Supreme Court of the United States

OCTOBER TERM, ~~1948.~~

Nos. ~~184 and~~ 185.

GRAVER TANK & MFG. CO., INC., THE LINCOLN ELECTRIC COMPANY, GRAVER TANK & MFG. CORPORATION,

Petitioners,

vs.

THE LINDE AIR PRODUCTS COMPANY,

Respondent.

ON WRITS OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

RESPONDENT'S ANSWER TO PETITION FOR REHEARING.

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RESPONDENT'S ANSWER TO PETITION FOR REHEARING.

The only question raised by the petition is whether this Court was correct in its unanimous decision that Lincolnweld 660 flux infringes Claims 18, 20, 22 and 23 of the Jones *et al.* patent.

All thirteen judges of the three courts have concurred in the decision on this point.

Petitioners nevertheless assert that the decision of this Court is inconsistent within itself and that this Court cannot at the same time hold Claims 24 and 26 *invalid* and hold Claims 18, 20, 22 and 23 *infringed*.

This Court's Decision Is Not Inconsistent.

Petitioners' contention is without merit. This Court affirmed the trial court's holding that Claims 24 and 26 were invalid upon the ground that claims which are unambiguously broader than the invention disclosed in the patent (because they include materials which are inoperative) cannot be saved by construing them as limited to the disclosures of the specification.

Neither the validity nor the infringement of Claims 18, 20, 22 and 23 involved any problem of construction. All three courts agreed, without a dissenting voice, that these claims conformed precisely to the disclosures of the specification, and were valid.

Infringement Was Based Upon a Finding That Petitioners Had Appropriated the Invention.

The Trial Court's holding of infringement was based—not upon a construction of the claims—but on its finding that petitioners had in fact appropriated the invention disclosed and claimed by the patentees. This was the import of the Trial Court's finding that petitioners' flux was in all respects the equivalent of those covered by a literal reading of the claims.

The fact that manganese could be substituted as an equivalent in the flux was not discovered independently by Lincoln. All three courts—the District Court, the Circuit Court of Appeals, and this Court—expressly concurred in the significant finding that Lincoln introduced no evidence

> "to show that the accused flux was derived from the prior art or by independent experiment, or from any source other than the teachings of the patent in suit." (Finding 22, R. 926; C. C. A. Op., R. 1003; 336 U. S. 276).

The Trial Court did refer to the specifications, but not as an aid in construing the claims covering alkaline earth metals. Infringement is not simply a matter of words, but of substance, and an inventor is entitled to a range of equivalents commensurate with the scope of his invention. *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S. 405, 415 (1908).

Since criteria of equivalence in the case of composition claims are known identity of operation and result (Respondent's Brief, pp. 63-4), the question before the court was whether manganese was in fact a known equivalent of the alkaline earth metals. There was abundant testimony in the record on this point (Respondent's Brief, p. 57 *et seq.*).

The Trial Court also had before it proof that the inventors had employed manganese as an equivalent of the alkaline earth metals in the very first experiment following the making of the invention (R. 43). The fact of this equivalence was reported in the patent itself.

That, alone, was conclusive of the fact that anyone skilled in the art would know that manganese is an equivalent of the alkaline earth metals, and the Trial Court very properly pointed it out. It was entirely proper for the court to refer to the specifications for this purpose; indeed, the specifications were the very best evidence that such equivalence was known in the art.

Furthermore as all three courts pointed out the knowledge of such equivalance made available by the patent to those skilled in the art had actually been utilized by petitioners.

The Trial Court's Determination of Infringement Rested Upon its Findings of Fact.

Defendants in the lower court squarely raised as an issue of fact, introduced testimony and argued at length,—that Lincolnweld 660 flux, although prepared in accordance with the teachings of the patent, was not an equivalent to compositions containing a principal proportion of alkaline earth metals. Judge Swygert rejected this contention and found (R. 925-7):

> "20. The accused Lincolnweld flux and the composition of the patent in suit *are substantially identical in operation and in result.*
>
> "21. The accused Lincolnweld 660 flux is a calcium manganese aluminum silicate with calcium fluoride added, which in welding operation *is in all respects equivalent to the compositions of the patent in suit.* [Then follows the chemical formula of the Lincolnweld 660 flux]
>
> "23. In the Lincolnweld 660 flux the slight excess of basic oxide over stoichiometric proportions does not substantially affect its operative character and follows the teaching of the patent.
>
> "22. A person skilled in the art can produce the accused Lincolnweld 660 flux by following the teaching of the patent in suit. No evidence was introduced to show that the accused flux was derived from the prior art or by independent experiment, or from any source other than the teachings of the patent in suit.
>
> "13. Manganese silicate is one of the nine metallic silicates which the specification discloses that the inventors have used as principal constituents in welding compositions attaining more or less effectively the objectives of their invention.
>
> "14. *The patent discloses that manganese* silicate, when used as a principal constituent of a weld-

ing composition prepared according to the teachings of the patent, *is a proper substitute* for the silicates of the alkaline earth metals.

"24. The patent in suit teaches the substitution of manganese for other basic oxides and is not limited to the use of a moderate amount of manganese in addition to other basic oxides." (Emphasis added.)

These findings represented the Trial Court's acceptance of the testimony of plaintiff's witnesses, and the rejection of the testimony of defendants' witnesses, as to whether a manganese silicate flux, prepared in accordance with the specifications, was in all respects the equivalent of the patented compositions.

The testimony of defendants' witnesses on this point was reviewed at length in defendants' trial brief, pages 79-81. Plaintiff's evidence was reviewed at pages 122-126 of its main brief before the Trial Court.

The Circuit Court of Appeals Reached the Same Conclusion On This Issue of Fact.

In the Statement of Points filed by petitioners in the District Court, as a basis for their appeal to the Circuit Court of Appeals for the Seventh Circuit, petitioners specifically took issue with Findings Nos. 13, 14, 20, 22, 23 and 24, quoted above. Moreover, petitioners claimed error in the Trial Court's failure to make the following findings proposed by defendants:

"(g) Manganese is not an alkaline earth metal, and manganese silicate therefore cannot be considered to be an alkaline earth silicate; nor is it an equivalent thereof.

"(h) Manganese silicate, as the major constituent in a composition of matter or fluxing material for

> electric welding, functions differently from calcium silicate and produces superior results, in that such manganese silicate increases the content of manganese in the weld metal instead of decreasing such content as does calcium silicate."

Point IV of petitioners' brief before the Circuit Court of Appeals in No. 9482 was entitled (p. 79):

> "Contrary to the Trial Court's finding, the evidence conclusively establishes that the accused 660 flux containing a major proportion of manganese silicate differs substantially in operation and result from the composition of the patent in suit, and therefore it is not an equivalent."

These contentions on the part of petitioners were answered in respondent's brief in No. 9482, beginning at page 59 and concluding as follows (at p. 60):

> "The important thing is that here, in a vital point in defendants' brief where they seek to upset the Trial Court's finding of identity in operation and result, all defendants have to offer are these two trivial and erroneous contentions as to the special Oxweld rod and the freedom from oil, rust and moisture."

The Circuit Court of Appeals for the Seventh Circuit unanimously rejected petitioners' attack upon these findings of the trial court, stating (R. 1003):

> "The court further found that the defendants used and sold their accused composition since 1942, and are still using it, and it is substantially identical in operation and result with that of the patent; and that such flux is a calcium manganese aluminum silicate, with calcium fluoride added, which in welding

operation is in all respects equivalent to the compositions of the patent; that a person skilled in the art can produce the accused flux of the defendants by following the teaching of the patent in suit; that no evidence was introduced to show that the accused flux was derived from the prior art or by independent experiment, or from any source other than the teaching of the patent in suit. It was further found that in the defendants' flux the slight excess of basic oxide over stoichiometric proportions does not substantially affect its operative character and it follows the teaching of the patent; that the patent teaches the substitution of manganese for other basic oxides and is not limited to the use of a moderate amount of manganese in addition to other basic oxides."

Supreme Court Briefs.

In the brief for respondent filed in this Court on December 24, 1948, Point III, beginning at page 57, reviews in some detail the large portion of the record which supports the trial court's findings that the Lincolnweld 660 flux is identical in operation and result with the preferred composition of the patent. Petitioners' counter-argument is to be found at pages 25-27 of their main brief, and pages 20-21 of their reply brief.

Conclusion.

Every point raised by the petition for rehearing was made in the Trial Court, in the Circuit Court of Appeals, and in this Court.

There is no need for further repetition of these arguments, which is the only purpose that would be served by

granting the petition. Accordingly, the petition for a rehearing should be denied.

Respectfully submitted,

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